presenting the advertising item to the user of the electronic publication in response to the access of a specific content item.

36. (New) The method of Claim 7, wherein said presenting step is carried out by presenting the advertising item to the user in response to the access by the user of a predetermined part of the specific content item.

REMARKS

Claim 7 has been amended, and Claims 24-26 have been added. The claims which are now pending in the present application are Claims 7-8 and 24-26. Added Claims 24-26 are dependent claims, which are identical to dependent Claims 25-27 of the parent application (U.S. Serial No. 08/673,986). Applicants had intended to add Claims 24-26 when the present continuation application was filed on December 8, 1999, but these claims were inadvertently omitted from the Preliminary Amendment which was filed on that date. Reconsideration of the present application, as amended, is respectfully requested.

The Office Action rejected Claim 7 under the second paragraph of U.S.C. §112 for indefiniteness, indicating that there is no antecedent basis for the phrase "the passage". It is noted that the phrase "the passage" appeared in Claim 7 throughout the examination of the parent application, and no objection was raised. Grammatically speaking, the phrase "the passage" is an accepted grammatical technique for referring to an elapse of a period of time. It is respectfully submitted that those skilled in the art would recognize that "the passage" was used in this context, rather than as a reference to some element of the claimed combination. Consequently, it is respectfully submitted that the reference to "the passage" did not involve any indefiniteness under 35 U.S.C. § 112. Nevertheless, in order to expedite examination of the present application, the foregoing amendments delete the word "the" from this phrase, leaving only "passage". It is respectfully submitted that amended Claim 7 is in compliance with the second paragraph of 35 U.S.C. §112.

Turning to the merits, Claim 7 stands rejected under 35 U.S.C. §102 as anticipated by Reilly U.S. Patent No. 5,740,549. This rejection is respectfully traversed, for the following reasons. Claim 7 recites a step of "presenting the advertising item to the user of the electronic publication after passage of a predetermined amount of time during which the electronic

publication has been in use". The "amount of time" recited in Claim 7 is thus a period which starts when the user begins using the electronic publication. The Office Action asserts that an equivalent time period is disclosed at lines 40-52 in Column 11 of Reilly. This portion of Reilly discusses a screen saver that can display news items and advertisements. The Office Action states that the news items and advertisements displayed by the screen saver constitute an electronic publication. Aside from the specific information displayed by the screen saver, the screen saver appears to work in a standard manner. In particular, when a user is using an application program, for example a word processor or spreadsheet, the screen saver is not visible. However, if there is no user input from the system's keyboard or pointing device for a specified period of time, then the screen saver becomes visible at the end of that time period, and displays the news items and advertisements. The time period discussed in Reilly does not begin when the user begins using the electronic publication. In fact, the electronic publication (including the news items and advertisements) is not made visible and thus cannot be used until after the end of the time period. This is significantly different from what is recited in Claim 7. Accordingly, it is respectfully submitted that Claim 7 is not anticipated under §102 by the Reilly patent. In fact, it is respectfully submitted that the subject matter of Claim 7 is sufficiently different from Reilly that it would not be rendered obvious by Reilly. Claim 7 is therefore believed to be allowable over Reilly, and notice to that effect is respectfully requested.

Claim 8 stands rejected under 35 U.S.C. §102 as anticipated by Reilly. Claim 8 recites the step of "presenting the advertising item to the user of the electronic publication in response to the access of a specific content item". That is, when a specific content item is accessed, it triggers the presentation of a specific advertising item. The Office Action asserts that this is disclosed in the Reilly patent from line 61 in Column 13 to line 14 in Column 14. However, it is respectfully submitted that this portion of Reilly does not teach or suggest the subject matter of Claim 8. More specifically, the indicated portion of Reilly explains that a user can select one of several different information categories, each of which includes multiple news items. Each category is associated with a respective group of several advertisements, and those advertisements are displayed in a rotating order at intervals of 30 seconds so long as the associated category is selected. When a new category is selected by the user, one of the advertisements associated with that new category is displayed, and then every 30 seconds after that the currently-displayed advertisement is replaced with a different advertisement from the

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group of advertisements associated with the new category. The presentation of advertisements is thus synchronized to the selection of a category, rather than to the selection of a specific news item within the current category. Reilly does not appear to teach or even suggest that the selection of any specific news item might trigger the display of an advertising item, much less a particular advertising item which is specifically associated with that specific news item. In contrast, and as noted above, Claim 8 recites a particular advertising item, and specifies that this particular advertising item is presented to the user "in response to the access of a specific content item". The indicated portion of Reilly does not appear to disclose anything which is even remotely similar. It is therefore respectfully submitted that the subject matter of Claim 8 is not anticipated under §102 by the indicated portion of the Reilly patent. Further, it is respectfully submitted that the subject matter of Claim 8 is significantly different from the indicated portion of Reilly, and that Claim 8 would thus not be rendered obvious by the indicated portion of Reilly. Claim 8 is therefore believed to be allowable over Reilly, and notice to that effect is respectfully requested.

Claims 24-25 and Claim 26 respectively depend from Claim 7 and Claim 8, and are also believed to be allowable over the art of record, for example for the same reasons discussed above with respect to Claims 7 and 8.

Applicants are enclosing a Power of Attorney in favor of the undersigned. Please note that the enclosed Power does not revoke any existing power, and does not change the correspondence address for this application.

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to contact the undersigned attorney by telephone at (214) 953-6684.

Although Applicants believe that no additional fees are due, the Commissioner is hereby authorized to charge any fees required by this paper, or to credit any overpayment, to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,
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